

REMARKS/ARGUMENTS

Applicants have carefully reviewed the Office Action mailed on July 6, 2007. Applicants respectfully traverse (and do not concede) all objections, rejections, adverse statements, and adverse assertions made by the Examiner. Claims 1-4, 6-8, 10, 13-14, 18-20, 25, 27, 53, 55, 58-59, 78, and 81-87 remain pending.

Claim Rejections under 35 U.S.C §103

Claims 1-4, 6-8, 10, 14, 19, 20, 25, 27, 53, 55, 58, 59, 78, and 81-87 are rejected under 35 U.S.C. §103(a) as being unpatentable over Jacobsen et al. in U.S. Patent No. 6,579,246 in view of Shiber in U.S. Patent No. 5,135,531, as evidenced by Hernandez et al. in U.S. Patent No. 5,396,212. Applicants respectfully traverse this rejection. Indeed, Applicants respectfully submit that the claimed invention is patentable over the cited art for the reasons set forth in the reply filed October 31, 2007 and respectfully request reconsideration of those remarks.

As Applicants have previously indicated, there has not been an adequately articulated reason or motivation to combine the cited art. The Supreme Court in *KSR Int'l Co. v. Teleflex Inc.* (550 U.S. __ 2007) states that:

[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.

See page 14 of the April 30, 2007 slip opinion. The Court went on to state:

[i]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.

Emphasis added; see page 15 of the April 30, 2007 Slip Opinion. Finally, in quoting *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006), the Court stated:

“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”.

Emphasis added; see page 14 of the April 30, 2007 Slip Opinion. The Court made clear that an obviousness rejection requires some articulated reason of why one skilled in the art would have been prompted to combine the elements on the claimed manner. Applicants respectfully submit that the Examiner has failed to do so.

In the Response to Arguments section on page 7 of the Examiner stated that:

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F. 2d 1071, 5 USPQ2d (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Jacobsen et al teaches the use of at least one type of "coil" at the distal end of the guidewire, while Shiber teaches the use of a coil having a rectangular cross-section. One of ordinary skill in the art would have been able to substitute the coil of Shiber with the coil of Jacobsen et al to obtain a guidewire capable of traversing the vasculature of the patient.

Applicants respectfully submit that the Examiner's stated rational does not meet the required threshold, and instead, is merely a conclusory statement. Because of this, the Examiner has failed to meet the burden necessary to establish a prima facie case of obviousness.

Applicants understand that the required reason or motivation may be found in the knowledge generally available to one of ordinary skill in the art. However, applicants do not see where the Examiner has articulated any such reasoning or motivation as required, and also fail to understand where the Examiner is finding such reasoning or motivation in this case. Shiber appears to teach the helical coil for improving the atherectomy device by providing a means for coring through an obstruction and providing a barrier for the cored material, to prevent the cored material from freely rotating around the guidewire. Applicants submit that one of ordinary skill in the art would have no reasonable expectation and would not recognize that the coring helical coil of Shiber would improve the guidewire of Jacobsen et al. in the same way. Shiber and Jacobsen et al. are directed to different devices with different structures and functions.

For at least the reasons set forth above, Applicants respectfully submit that claims 1-4, 6-8, 10, 14, 19, 20, 25, 27, 53, 55, 58, 59, 78, and 81-87 are patentable over the cited art. Reconsideration and withdrawal of the rejection are respectfully requested.

In addition, regarding claims 25, 27, and 82-84, claim 25 recites that the proximal end (of the tubular member) abuts the abrupt change in cross-sectional dimension (of the core wire). Notwithstanding the Examiner's comments on page 8 of the office action (regarding the Examiner's assertion that the core wire comprises a section having an abrupt change in cross sectional dimension), Jacobsen et al. does not appear to teach or suggest a tubular member that has a proximal end abutting the abrupt change in cross-sectional dimension (of the core wire). Indeed, a medial coil 532 is disposed between the micromachined tubing 514 and the core wire 501 in Jacobsen et al. Because of this, the micromachined tubing 514 does not appear to abut any portion of the core wire 501. Based on this distinction, Applicants respectfully submit that claim 25 is patentable over Jacobsen et al. because Jacobsen et al. does not appear to teach or suggest all the claim limitations of claim 25. Shiber fails to overcome this deficiency. Consequently, Applicants respectfully submit that 25 is patentable over the combination of Jacobsen et al. and Shiber, to the extent that such a combination is even possible. Because claims 27 and 82-84 depend from claim 25, they are also patentable over the cited art for the same reasons as claim 25 and because they add significant elements to distinguish them further from the art.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jacobsen et al. and Shiber, as evidenced by Hernandez et al. as applied to claim 7 above, and further in view of Lui in U.S. Patent Application Publication No. 2002/0010475. For the reasons set forth above, Applicants respectfully submit that claim 7 is patentable over Jacobsen et al. and Shiber, as evidenced by Hernandez et al. Lui fails to overcome the deficiencies of the cited art. Consequently, Applicants respectfully submit that claim 7 is patentable over the cited art. Because claim 13 depends from patentable claim 7, it is also patentable for the same reasons as claim 7 and because it adds significant elements to distinguish it further from the art.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jacobsen et al. and Shiber, as evidenced by Hernandez et al. as applied to claim 7 above, and further in view of Levine et al. in U.S. Patent Application Publication No. 2003/0009157. For the reasons set

forth above, Applicants respectfully submit that claim 7 is patentable over Jacobsen et al. and Shiber, as evidenced by Hernandez et al. Levine et al. fails to overcome the deficiencies of the cited art. Consequently, Applicants respectfully submit that claim 7 is patentable over the cited art. Because claim 18 depends from patentable claim 7, it is also patentable for the same reasons as claim 7 and because it adds significant elements to distinguish it further from the art.

Conclusion

Reexamination and reconsideration are requested. It is respectfully submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is also respectfully requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,
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By their attorney,

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